

b.) Remarks

Claim 1 has been amended in order to more specifically recite the subject matter of the present invention. Additionally, claim 8 is presented in order to better recite a preferred embodiment of the present invention. The subject matter of the amendment is found in the specification as filed, *inter alia*, in original claim 7, at page 10, lines 11-14 and page 11, lines 6-10. Accordingly, no new matter is added.

In the August 25, 2005 Office Action, the Examiner rejected claims 1-7 under 35 U.S.C. §103 as being obvious over JP 08-323049 in view of JP 63-43094. According to the Examiner, JP 08-323049 taught all the features of previous claim 1, except for providing a back surface with a reversible metachromatic layer. Such layer was said to be taught by JP 63-43094. Therefore, the Examiner concluded it would have been obvious to combine the reversibly metachromatic layer of JP 63-43094 into JP 08-323049

“for the purpose of creating visual excitement when a child is playing with the toy.”¹

In response, Applicants explained the present invention provides first and second resin layers superposed on both sides of the foamed substrate, where one layer bears a separate metachromatic layer. By this feature, the foamed substrate is prevented from warpage, e.g., due to the sandwiched resin layers.

¹ The Examiner also considers the functional features of claim 4 to be inherent with the device of Takeda [JP 08-323049].” The basis for this is not well-understood. To the extent such statement is maintained, the Examiner is respectfully requested to provide Applicants with a personal affidavit under MPEP §2144.03.

Moreover, Applicants explained that neither of the Japanese references, whether taken singly or together, provide two resin layers plus a metachromatic layer. That is, the combination of JP 63-43094 with JP 08-323049 only provides one resin layer, a foamed substrate and a metachromatic layer.

Accordingly, Applicants' resin layer differ from the reversibly metachromatic layer of JP 08-323049, and even if there was motivation to combine the reversibly metachromatic layer of JP 63-43094 with JP 08-323049, such still would not have made a *prima facie* case of obviousness.

In response, the Examiner stated (see the December 14, 2005 Advisory Action) that motivation to combine can arise from either within or outside the references and "takes the position that the combination of the two [Japanese references] would prevent warpage to the substrate."

Whether or not this is true, it is off-point and still does not address Applicants' arguments. That is, the combination does not provide two resin layers and a reversible metachromatic layer and so cannot render the claimed invention obvious. Moreover, Applicants pointed out the present invention was remarkably superior to providing a resin sheet on only one side of the formed substrate as shown in the closest prior art, namely JP 08-323049, as evidenced by Comparative Examples 1 and 2. The Examiner's combination also fails to suggest the dramatic advantages achieved by the present invention.

In that latter regard, as seen in Examples 1-17, the toy according to the present invention is free from warpage (see Example 1 at page 27, lines 17-19, Example 2 at page 30, lines 3-5, Example 3 at page 31, lines 11-13, Example 4 at page 33, lines 21-

23, Example 5 at page 36, lines 6-8, Example 6 from page 36, line 26 to page 37, line 1, Example 7 at page 38, lines 17-19, Example 8 at page 41, lines 4-6, Example 9 at page 43, lines 11-13, Example 10 at page 44, lines 13-15, Example 11 at page 46, lines 22-24, Example 12 at page 48, lines 18-20, Example 13 at page 50, lines 14-16, Example 14 at page 52, lines 25-27, Example 15 from page 54, line 26 to page 55, line 1, Example 16 at page 52, lines 1-3 and Example 17 at page 59, lines 10-13.

As noted therein, in each of these Examples the

“reversibly metachromatic toy 1 was free of any warpage or deformation of the foamed substrate 2”
(emphasis added).

In contrast, when a resin layer is provided only on one substrate, the foamed substrate 2 warped badly (see Comparative Example 1 at page 60, lines 9-10 and Comparative Example 2 at page 60, lines 22-23.)

In fact, the Comparative Examples are exactly the Examiner’s combination of the Japanese references. As shown in Comparative Examples 1 and 2 the presence of a reversibly thermochromatic layer without an underlying resin layer was insufficient to prevent warpage. However, in Example 1, the resin layers 3a, 3b were non-metachromatic white ink containing a polyurethane resin. Resin layers 3a, 3b carried reversibly metachromatic layers 4a and 4b prepared by dispersing a reversibly thermochromatic microcapsule pigment in a urethane resin. Only by providing the metachromatic layer atop a resin layer (as claimed) was warpage prevented. However, a resinous metachromatic layer alone (of the Examiner’s combined prior art) warped badly.

The advantages achieved by the present invention are of clear utility to those of ordinary skill and are entirely unexpected in view of the prior art. Yet they have

not been addressed by the Patent Office, to date. Moreover, the Examiner has also not addressed Applicants' argument that there is no *prima facie* obviousness.

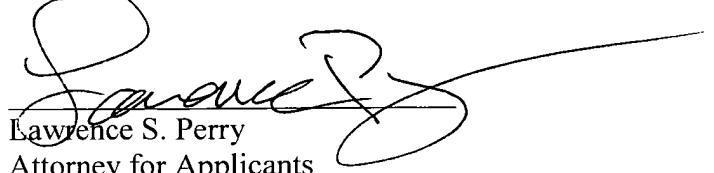
Nonetheless, solely in order to reduce the issues, Applicants have amended their claims in order to even further distinguish the prior art.

As the Examiner will appreciate, JP 8-323049 does not teach or suggest a foamed resin substrate formed as a plate which has been expanded 5 to 40 times. Additionally, these references also fail to teach or suggest forming each laminate is formed with at least one hole, and joining or fastening the laminates together through the holes. For these reasons as well, Applicants respectfully submit that the pending claims recite patentable and unobvious subject matter.

Entry hereof is earnestly solicited.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,


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